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23373 7590 02/18/2011 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* YASUO MIZOTA

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Appeal 2009-010798  
Application 10/540,552  
Technology Center 1700

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Before ADRIENE LEPIANE HANLON, TERRY J. OWENS, and  
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-6, which are the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

We REVERSE.

Representative claim 1 reads as follows:

1. A tire structural member fabricating method, which fabricates a tire structural member by successively and contiguously attaching strips to a convex outer surface having an outwardly convex cross section of a forming drum by a strip feed device such that the strips extend obliquely to a center axis of the forming drum, said method comprising the steps of:

continuously attaching strips to the convex outer surface of the forming drum by successively feeding strips onto the convex outer surface by the strip feed device, while the strip feed device is being moved parallel to the center axis of the forming drum relative to the forming drum at a fixed speed from an axial end of the forming drum to another end thereof and while the forming drum is being rotated about the center axis thereof; and

controlling the rotation of the forming drum such that the angular velocity of the forming drum varies gradually and continuously from a minimum angular velocity at a moment a leading end of the strip is attached to the convex outer surface of the forming drum to a maximum angular velocity at a moment the strip is attached to a middle part of the convex outer surface of the forming drum and from the maximum angular velocity to a minimum angular velocity at a moment a trailing end of the strip is attached to the convex outer surface of the forming drum, the minimum angular velocity at the moment the trailing end is attached being equal to the minimum angular velocity at the moment the leading end is attached.

Claims 1-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined prior art of Ogawa (US 6,461,459 B1, issued Oct. 8, 2002), Marchini (US 6,702,913 B2, issued Mar. 9, 2004), and Hitotsuyanagi (US 2002/0046796, published Apr. 25, 2002).

#### OPINION

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

“[R]ejections on obviousness grounds cannot be sustained by mere

conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) quoted with approval in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

The fact finder must be aware “of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. at 421(citing *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966) (warning against a “temptation to read into the prior art the teachings of the invention in issue”)).

Applying the preceding legal principles with respect to obviousness to the factual findings in this record, we determine that the Examiner has not properly identified factual findings and reasoning for establishing a prima facie case of obviousness based on the applied prior art for the reasons explained by Appellants in the briefs (*see generally* App. Br.; Reply Br.).

Notably, the deficiency of the Examiner’s obviousness conclusion is that, even if the teachings of the prior art references were combined as suggested by the Examiner, the Examiner has not articulated any persuasive reason why the artisan would have modified Ogawa to result in “the angular velocity of the drum varies gradually and continuously” in the claimed sequence for each strip. In this regard, we agree with Appellants that neither Hitotsuyanagi, nor any other applied reference, teaches or suggests claim 1’s requirement of “controlling the rotation of the forming drum such that the angular velocity of the forming drum varies gradually and continuously from

a minimum angular velocity” in the claimed sequence (Reply Br. 7; *see also* App. Br. 15), nor the corresponding requirement in apparatus claim 4.<sup>2</sup>

Under these circumstances, it is apparent that the only teaching or suggestion for combining the applied references in such a manner as to achieve the here claimed invention derives from the Appellants’ own Specification rather than the applied prior art. Therefore we conclude that the Examiner’s rejection is improperly based upon improper hindsight reasoning. *See W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”).

On this record, we cannot say the Examiner has established a prima facie case of obviousness within the meaning of 35 U.S.C. § 103(a) for the claims on appeal. For these reasons and those set out in the Briefs, we reverse the Examiner’s § 103 rejection on appeal.

#### CONCLUSION

In summary, the rejection before us on appeal is reversed.

#### REVERSED

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<sup>2</sup> Claim 4 is a corresponding independent apparatus claim to method claim 1. Claim 4 requires “a controller” that necessarily is programmed to “control[] the strip feed driving motor and the drum driving motor such that the angular velocity of the forming drum varies gradually and continuously” in the same claimed sequence as recited in claim 1. (*See*, Claims Appx., claim 4)

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